

## **REMARKS**

Applicant respectfully requests reconsideration of the subject application for the reasons set forth herein.

### **Amendment After Final**

Entry of this amendment is respectfully requested on the ground that this amendment places the application in condition for allowance. Alternatively, entry of this amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

### **Nonstatutory Double Patenting**

Claims 1-3, 16, 17, 19-22, and 25-31 stand rejected on the ground of nonstatutory obviousness-type double patenting over Claim 22 of U.S. Patent No. 6,959,183 (the “183 Patent”). Applicant respectfully traverses these rejections for at least the following reasons.

The M.P.E.P. § 804 recites, in part:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg*, 140 F.3d 1428, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); *In re Van Ornum*,

686 F.2d 937, 214 U.S.P.Q. 761 (C.C.P.A. 1982); *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970); and *In re Thorington*, 418 F.2d 528, 163 U.S.P.Q. 644 (C.C.P.A. 1969).

Furthermore, an obviousness-type double patenting rejection is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. § 103." *In re Braithwaite*, 379 F.2d 594 (C.C.P.A. 1967); M.P.E.P. § 804. Thus, any analysis employed in an obviousness-type double patenting rejection is basically the same as the analysis employed for a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985); M.P.E.P. § 804.

In a §103 obviousness analysis, the holding in *In re Vaeck* applies and, in light of the above discussion, *In re Vaeck* thus applies in an obviousness-type double patenting analysis. In *In re Vaeck*, the court held that, to establish a prima facie case of obviousness, three basic criteria must be met. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference must teach or suggest all claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must not be based on an applicant's disclosure. *Id.* Thus, the obviousness-type double patenting rejection currently standing on Claims 1-3, 16, 17, 19-22, and 25-31 must meet the criteria specified under *In re Vaeck* and the relevant section in the M.P.E.P.

#### The '183 Patent Does Not Teach Applicant's Invention

The Office Action states that "Applicant's arguments filed on 06/02/2006 have been fully considered but they are not persuasive." *Office Action of July 6, 2006*, at 4. The

Office Action states that “a limited region could be a modeled region and vice versa. Hence, it is believed that ‘183 patent still includes the claimed limitations.’ *Id.*, at 5. Applicant respectfully agrees that a limited region *could be in some cases*, a modeled region. However, the fact that that a claim and a reference *could be* the same is not the standard of law by which a claim is deemed obvious over a reference. The proper standard of law, as stated above, is that the reference must teach or suggest all claim limitations. *In re Vaeck*, 947 F.2d 488 (emphasis added). Thus, the scope of the reference must fully encompass the scope of the claim in order to deem the claim obvious. If a reference includes some, but not all, of the scope of a claim, the reference cannot be deemed to teach the claim. If not all of the scope of a claim is taught by a reference, then the claim is not obvious over the reference.

Independent Claims 1 and 16 both disclose methods of providing cellular wireless communications services “wherein...[a] modeled geographic area approximates at least one municipal region indicative of anticipated participation” of a subscriber or a user “in at least one selected from the group consisting of living, working, playing, shopping, and traveling.” The Office Action states that Claim 22 of the ‘183 Patent discloses, in part, a “limited geographic area that approximates at least one municipal region in which the subscriber substantially lives, works, and plays.” *Office Action of July 6, 2006*, at 3-4. Applicant respectfully asserts that Claims 1 and 16 are not anticipated by the ‘183 Patent.

First, Applicant respectfully asserts that, conceptually, a “limited” geographic area is different from a “modeled” geographic area. As taught in the specification of the present invention, a “modeled geographic area” is a geographic area that has been subjected to modeling or a model of some kind. Nowhere in the claims of the ‘183 Patent is a modeled area, modeling, or subjecting an area to a model disclosed or claimed. The ‘183 Patent only discloses that a

geographic area is “limited.” Conceptually, the term “limited” does not encompass the process of subjecting something to a model or the modeling process and does not include the limitation of subjecting the geographic area to a model. Thus, by concept alone, Claims 1 and 16 of the present invention are different from those in the ‘183 Patent and, thus, the ‘183 Patent does not make Claims 1 and 16 obvious.

Second, Applicant respectfully asserts that, while a limited region, in some cases, may be a modeled region, a limited region does not fully encompass a modeled region because the scope of “limited” and the scope of “modeled” vary. Applicant respectfully asserts that the scope and meaning of a *modeled* geographic area is different from the scope and meaning of a *limited* geographic area because a modeled geographic area is an area that has been constructed according to certain parameters, while a limited geographic area is an area that has been merely restricted. In one example, a limited geographic area may be the area encompassed by the city of Miami, Florida. But a modeled geographic area, in contrast, may be sections of Miami (which may not include all of Miami) and areas in the surrounding suburbs which offer the best reception to wireless device users (if the model is the inclusion of areas offering the best reception to wireless devices or even including regions of the Atlantic Ocean or Gulf of Mexico). Thus, while *some* of the modeled geographic area may be the same as the limited geographic area, *not all* of it is because, when the area is modeled, area may be both added and also further defined.

In another example, a limited geographic area may be the area limited to the state of Alaska. Also consider, for example, a model, wherein the model includes all places in the U.S. where the temperature of these areas is above 0°C on October 1, 2006. If everywhere in Alaska was below 0°C on October 1, 2006 and everywhere in the U.S. except for Alaska was

above 0°C on October 1, 2006, then Alaska would not fit the model and Alaska would not be included. Thus, in this example, Alaska (the limited geographic area) and the rest of the U.S. (the modeled geographic area) are mutually exclusive, even though, before applying the model to all of U.S., the modeled geographic area could encompass all or part of Alaska. This example illustrates the conceptual differences between what is meant by “limited” and “modeled.” While, theoretically, some modeled geographic area could be physically a part of a limited geographic area, the concept of applying a model to a geographic area is completely separate and distinct from merely saying the area is limited. Thus, a “limited” geographic region and a “modeled” geographic region are not one in the same. Because a “limited” geographic region and a “modeled” geographic region are not one in the same, the ‘183 Patent does not teach the claims of the present invention. Thus, because Claims 1 and 16 are not taught by the ‘183 Patent, Claims 1 and 16 are patentable over the ‘183 Patent in this regard.

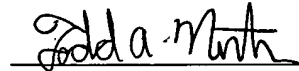
Accordingly, Applicant submits that at least Claims 1 and 16 are patently distinguishable over the ‘183 Patent. Applicant further submits that Claims 2, 3, 17, 19-22, and 25-31 are similarly distinguishable over the ‘183 Patent by virtue of their ultimate dependency from a patently distinct base claim.

**Conclusion**

Wherefore, Applicant respectfully believes all outstanding grounds raised by the Examiner have been addressed, and thus respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Respectfully submitted,

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